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Inventor: Robert Filepp et al.

Group Art Unit: 2412

Serial No.: 08/158,031

Examiner: Joseph H. Field

Filed: November 26, 1993

Title: METHOD FOR PRESENTING APPLICATIONS
IN AN INTERACTIVE SERVICE

AMENDMENT

Commissioner of Patents and Trademarks
Washington, D.C. 20231

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Sir:

In response to the Official Action dated January 16, 1997, Applicants request that the following amendments be entered in their application, and that their application be reconsidered in light of those amendments and the related remarks presented below.

In the Claims:

1. (Thrice Amended) A method for presenting interactive applications [of an interactive service provided] on a computer network, the network including a multiplicity of user reception systems at which respective users may request a multiplicity of available [service] applications, the respective reception systems including a monitor at which the applications requested can be presented as one or more screens of display, the method comprising the steps of:

a. generating a screen display at [the] a respective reception system[s] for a requested application [of the interactive service], the screen display being generated by the respective reception system from data objects having a prescribed data structure, at least some of which objects may be stored at the respective reception system, the

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E' screen display including a plurality of partitions, the partitions being constructed from [information elements] objects, [having a prescribed structure,] the [elements] objects being [stored in the network] retrieved from the objects stored at the respective reception system, or if unavailable from the objects stored at the respective reception system, then from the network, [and retrievable at the respective reception system] such that at least some of the [elements] objects may be used in more ^{than} ~~that~~ one application, 8/16/97

b. generating at least a first partition for presenting applications; and

c. generating concurrently with the first partition at least a second partition for presenting a plurality of command functions, the command functions including at least a first group which are selectable to permit movement between applications.

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2. (Thrice Amended) The method of claim 1 wherein the [elements for constructing the partitions are] data structure of the objects includes a header and one or more data segments and wherein generating the second partition includes providing the first group of command functions with a first subgroup of command functions which are selectable to permit random movement between applications.

3. (Thrice amended) The method of claim 2 wherein the objects are stored at the respective reception systems in accordance with a predetermined plan, and wherein providing the first subgroup of commands includes providing a command for causing the user to be presented with a t least one procedure for navigating to a new application.

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4. (Twice amended) The method of claim 2 wherein the predetermined plan for storing objects at the respective reception systems includes providing the objects with a storage control parameter in their respective headers, and wherein providing the first subgroup of command functions includes providing at least one command for causing

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the user to be presented with a plurality of different procedure for navigating to a new application.

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5. (Amended) The method of claim 4 wherein the object storage controle parameter is dependent on the currency of the object data, and wherein providing the navigation procedures includes enabling the user to enter a character string at the reception system to randomly search the available applications for a desired application.

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10. (Twice Amended) The method of claim 2 wherein the objects are stored at the respective reception systems in accordance with a predetermined plan, and wherein providing the first subgroup of command functions includes providing at a command for enabling the user to progress through a sequence of applications previously designated.

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11. (Amended) The method of claim 10 wherein the predetermined plan for storing objects at the respective reception systems includes providing the objects with a storage control parameter in their respective headers, and wherein providing the user with a command for progressing through a sequence of applications includes enabling the user to adjust the application sequence.

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12. (Twice Amended) The method of claim 1 further including generating at least a third screen partition concurrently with the first and second screen partitions for presenting a second application and wherein the data structure of the objects includes a header and one or more data segments.

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13. (Amended) The method of claim 12 wherein the objects are stored at the respective reception systems in accordance with a predetermined plan, and wherein the predetermined plan for storing objects at the respective reception systems includes

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providing the objects with a storage control parameter in their respective headers , and
wherein presenting a third screen partition includes presenting the second application
as advertising.

14. (Amended) The method of claim 1 further including generating one or more
window partitions that overlays at least a portion of the application partition, the one
or more windows for presenting data associated with the application displayed and
wherein the data structure of the objects includes a header and one or more data
segments, and wherein the objects are stored at the respective reception systems in
accordance with a predetermined plan, which includes providing the objects with a
storage control parameter at their respective headers.

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17. (Amended) The method of claim 1 wherein generating the first and second
screen partitions includes generating the respective partitions at fixed, predetermined
regions of the display screen, the second partition being arranged as a command bar
and wherein the data structure of the objects includes a header and one or more data
segments, and wherein the objects are stored at the respective reception systems in
accordance with a predetermined plan, which includes providing the objects with a
storage control parameter at their respective headers.

REMARKS

THE OFFICIAL ACTION

In the Official Action of January 16, 1997, the Examiner:

- Acknowledged discussions with Applicants' attorney in August of 1996 concerning a pending, previously issued final rejection;
- Officially withdrew the final rejection in view of arguments advanced by Applicants;

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- Entered an amendment to claim 1 said to have been submitted by Applicants;
- Noted that a new search of the art had been undertaken; and
- Issued a new, non-final rejection of all of Applicants' claims under 35 U.S.C. § 103 based on an article by Scheifler et al. concerning the X Windows System as variously combined with U.S. patent 5,050,105, Peters and the Microsoft Windows User's Guide Ver. 2.0, all newly cited in the January 16, 1997 Action.

First, Applicants would like to again thank the Examiner for having undertaken the telephone interviews referred to, which were actually conducted on August 20-21, 1996, rather than just August 21, 1997; and for the Examiner's subsequent withdrawal of the then pending final rejection of Applicants' claims.

Further, with regard to the noted amendment, Applicants would like to point out that relative to those interviews, and as the Examiner will recall, the amendments to claim 1 were proposed on the understanding Applicants' claims would be allowed if those amendments were made. Accordingly, since the Examiner subsequently decided not to allow the claims, but, rather, to again search the art in contemplation of issuing a new, non-final action, the amendments to claim 1 should not have been entered. However, in view of the new rejection issued in the January 16, 1997 action, and Applicants' response herein, notation of this point has relevance only in so far as it identifies the form of the claims which the amendments of their current reply are drawn to.

Turning next to the Examiner's rejection of Applicants' claims on grounds of obviousness, Applicants would respectfully submit that the rejections are improper both as a matter of fact and as a matter of law and, accordingly, they must be withdrawn. The art newly cited neither alone nor in combination suggest or discloses Applicants' invention. Moreover, the Examiner has failed to establish a *prima facie* case of obviousness to support the rejection asserted. The rejections must be withdrawn.

APPLICANTS' INVENTION AND THE ASSERTED CITATIONS

In Paragraph 3 of the January 16th Action, the Examiner rejected Applicants' claims 1-4, 8, 9/8 and 12-17 under 35 U.S.C. §103 as obvious in view of an article by R. W. Scheifler and J. Gettys entitled *The X Windows System*, published April 1986 in *ACM Transactions on Graphics*, Vol 5, No. 2, pgs. 79-103 (Scheifler et al.).

However, not only does Scheifler et al. not suggest or disclose Applicants' invention, but, in fact, it teaches away from it. And, this is immediately apparent from a comparison of Applicants' claims when read in light of their specification, with the Scheifler et al. article.

As described in their specification, Applicants' invention is directed to a method for providing very large numbers of simultaneous users; for example, millions, access over a network to large numbers; for example thousands, of interactive applications which include pre-created, interactive text/graphic sessions. More particularly, Applicants' method features steps for generating screen displays at respective user terminals referred to as "reception systems", the screen displays including a plurality of partitions for concurrently presenting at least a user-requested application and a group of command functions for managing the display, the group of command functions including a subgroup of functions for randomly selecting applications for display. Still further, the method also includes steps for opening and closing windows on the display, and for presenting additional partitions suitable for concurrently displaying added applications that could include advertising.

As Applicants explained in their specification, among the principal objectives of their method are the providing of user-requested applications in minimal response time and at minimal cost. As noted by Applicants, they believed that to be commercially successful, their method would have to meet users demands for quick responses to application requests, and do so at low cost.

Accordingly, in designing their method Applicants determined that to achieve these objectives they would undertake to minimize communication over the network required to satisfy user requests. Further they determined they would do this by

enabling the user reception system to preform the data processing necessary to execute the requested applications, and to confine the network host activity to merely supplying; i.e., "serving," the raw program code and display data for generating the applications. With this approach, less time would be required to satisfy a user request since processing would be done at the user's reception system, and less cost would be associated with the presentation because the user's reception system would do the data processing rather than the host. Still further, host computing resources could be less sophisticated and, accordingly more cost effective if a host was called upon to simple serve raw data rather than process it for presentation.

Moreover, Applicants' further determined that in view of the limited storage resources typical of user reception systems, to efficiently realize such "distributed processing" they would devise procedures for organizing the raw application program code and display data so that it could be efficiently distributed in the network for use by the respective reception systems. Accordingly, Applicants determined to organize the application code and data as data objects having respective headers and data segments that would permit at least partial caching at the limited resources of the respective reception systems, and ready availability of objects from the network where reception system resources could not accommodate all the objects required.

Accordingly, Applicants' claim 1 expressly noted that the displays used in presenting applications included partitions that were generated from information elements which are defined in Applicant specification as data objects, and that the noted objects are available from the network; e.g., the respective reception systems, for generating at the respective reception system the noted partitions.

However, despite these fundamental and clear distinctions of Applicants' claimed invention over the art, the Examiner persists in rejecting Applicants' claims. Accordingly, to further clarify their invention, and to advance prosecution, Applicants, have amended their claims to expressly recite that screen displays are generated by the respective reception systems from data objects having a prescribed structure, and that at least some of the data objects may be stored at the respective reception system. Still

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further, Applicants have expressly amended their claim 1 to indicate that objects are retrieved by the respective reception systems for generating the screen partitions either from the store maintained at the reception system or from the network.

As noted, the Examiner contends that the Scheifler et al. article concerning the X Windows System renders Applicants' invention obvious. However, the Scheifler et al. Article neither alone, nor in combination with other cited art discloses or suggests Applicants' invention. Indeed, not only does the Scheifler et al. neither suggest nor disclose Applicants invention, but in fact, they teaches away from it.

As is well known by those skilled in the art, the X Windows System is a graphic protocol developed for presenting "windows" in high-speed local area networks. Further it is fundamental to X Windows that a host and terminal undertake cooperative execution of an application to facilitate its presentation, thereby mandating that communication between the host and terminal be maintained. Accordingly, the X Windows approach compels continued processing by the host with its attendant burden of processing and communication and associated time and cost burdens. Additionally, X Windows expressly seeks to avoid processing at the user terminal which typically lacks the computing resources sufficient to execute the application sought to be displayed.

As described in the article *Designing User Interface Tools For X Windows Systems*, by S. McGregor, *COMPCON Spring '89 IEEE Computer Society International Conference*, cite by the Examiner as background, and not a reference here in view of its publication date, X Windows consists of a number of components, particularly: X Lib; X Toolkit; X Wire; and X Server. In accordance with the X Windows design, several of these components must exist on the host that executes the application to be displayed, specifically, X Lib; X Toolkit; and, at least one, X Server, at the user terminal where display is provided. As suggested by McGregor, the X Wire module is provided between X Lib and X Server and defines the interface that handles communication between the host and terminal. McGregor, pg. 243.

McGregor notes that in operation, and with respect to communication from the host to the display terminal, X Lib as it residing on the host; i.e., the machine executing the application, converts the application procedures calls into lower-level graphics and windows-management commands. These communications in turn are sent by means of the X Wire module to the X Server module provided at the terminal where display will be executed. Thereafter, the X Server module converts the application calls into commands that are compatible with the display.

With regard to communication from the display terminal to the host, the X Server interprets keyboard events at the terminal and then sends them by means of the X Wire module to the X Lib module at the host for conversion into a form that can be used by the application running on the host. McGregor pgs. 243, 244.

McGregor goes on to note that the advantage of this system is that the terminal at which the display is provided can use the X System, to access computing resources at the host for executing complex applications which otherwise would not be executable at the terminal. In the illustration McGregor uses he notes, "for example, a user with a relatively low-cost workstation might access a remote application running on a fast computer server through one window, and an on-line database via a networked server through another." McGregor pg. 244.

However, X Windows System use of host resources and attendant communication delay and cost is exactly what the Applicants' invention, as described, seeks to avoid.

Though not as simply expressed, the Scheifler et al. publication relied on by the Examiner, also describes the X Windows System as being based on a network interprocessing protocol. Specifically, Scheifler et al. note that X Windows enables applications at one entity of a network; for example, a host, to cooperate with and communicate over a local area network to another entity; for example the displays of a user terminal. Scheifler et al. pg. 79, bottom, through pg. 80 top.

Still further, in Fig. 1, at p. 85, Scheifler et al. illustrates an X Windows System as including a user terminal having a screen, mouse, and keyboard coupled to a device

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library which is itself coupled to an X Server. As shown, the user terminal and its X Server is, in turn, connected to the network, and the network, in turn, in conventional local-area-network fashion is connected to a number of hosts; i.e., machines for executing applications. As is evident from Fig. 1, each of the applications is connected to the network through an X Lib. Still further and as is also plain, the windows manager is provide on the host and again coupled to the network through an X Lib. Moreover, the noted description of Fig. 1 and the X System is yet further explained at pgs. 84 - 86 where it is made clear that the application (host) and X Server (terminal) continually communicate with each other in order to support system operation. For example, at the bottom of pg. 86 through the top of pg. 87, Scheifler et al. make express reference to the "round-trip" procedure; i.e., host to terminal, terminal to host, and the high-speed local area network required to support this X Windows operation.

As is clear, X Windows with its reliance on and encouragement of host-terminal communication is the antithesis of Applicants' teaching.

Moreover, in asserting the Scheifler et al. article, the Examiner has yet further inconsistently and improperly characterized the Scheifler et al. teaching particularly as it is alleged to relate to Applicants' invention. For example, in Paragraph 3, line 1, of the Action, the Examiner contends that Scheifler et al. disclose the use of data objects having a prescribed data structure for constructing the Scheifler et al. windows. However, a reading of the Scheifler et al. article shows they simply is not so. Rather, X Windows provides for use of so called "high-level" primitives; i.e., graphic forms, which may be coded so communication from the host-maintained application can be sent in abbreviated form. Scheifler et al. pg. 92, bottom to pg. 93, top. . See also pg. 90, middle where window primitives such as borders and backgrounds are discussed.

But, as is well understood by those skilled in the art, primitives and other graphic fundamentals are not "data objects" for containing application code and/or display data as taught by Applicants. And, as is also well understood, nor are they data elements from which applications and their displays can be generated. They, simply, are not structures for managing raw data to be used in processing at the terminal.

Still further, though the Examiner nakedly contends that Scheifler et al. disclose storage of data objects in the network, however, he neither justifies his assertion with explanation, nor provides support for it with any page reference in the Scheifler et al. article. In fact, what Scheifler et al. do show is the placement of application computing resource away for the terminal at which display is to be undertaken, thereby compelling subsequent communication with the terminal with its attendant burden of communication delay and expense.

Additionally, nor are the Examiner's attempt to confuse X Windows resources such as frames, fonts, mouse cursor, etc. any more persuasive. Again, as is well known by those skilled in the art, those items simply represent graphic forms which may be incorporated into the display, but, they do not represent data structures which can be processed to generate application and screen displays. Further, and again as would be appreciated by one skilled in the art, the Scheifler et al. reference to "identifiers" for such resources, as the name implies, are nothing more than a means for identifying the resources that were created. They are not data objects having a prescribed data structure for transporting data across a network, and facilitating its storage and processing.

Yet additionally, despite the Examiner's contentions to the contrary, the resources the Examiner refers to in X Windows, as noted, are not data objects and they can not be used between successively executed applications. As expressly describe in Scheifler et al., resources of one application are made to extinguish when the application that originated it extinguishes. Scheifler et al. pg. 88, end of first full paragraph.

As would be immediately apparent to those skilled in the art, that Scheifler et al. simply makes no suggestion of data object use; or the execution of objects at the user terminal (reception system) for the generation of screen displays; or the storage of data objects at the reception system to effect generation of the screen display from a terminal; i.e., a reception system.

Continuing, as noted, in addition to failing to properly interpret the Scheifler et al. disclosure, the Examiner has further inconsistently asserted it. For example, after

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having contended at length through pg. 4 of the Action that Scheifler et al. disclose use of data objects having a prescribed data structure, which as shown above is incorrect, the Examiner at pg. 5 of the Action admits that Scheifler et al. do not teach "objects." However, the Examiner then goes on to assert that use of "objects", would be obvious in view of the Scheifler et al. disclosure of "identifiers" applied to X Window resources.

This assertion, however, is without foundation and improper. As pointed out above, resource identifiers have nothing to do with the data objects taught by Applicants. The "identifiers" of Scheifler et al., as noted, are as their name indicates a means for identifying graphic forms. Identifiers are not, nor do they suggest, data structures for containing raw program code and data to be transported over the network, stored, and executed at a reception system for generating screen display as are the data object recited in Applicants' claims and used in Applicants inventive method.

Yet additionally, the Examiner attempts to further support his assertion of data object obviousness by contending the Scheifler et al. at pg. 80 discloses use of "high-level object definitions from a structured files." This assertion, however, again demonstrates the lack of technical merit in the Examiner's analysis.

In the article section referred to by the Examiner at pg. 80, Scheifler et al. are discussing forerunner systems of X Windows. As noted by Scheifler et al. VGTS was an windowing system which W Windows, an unacceptable forerunner of X Windows, was built as an alternative to. VGTS is not a part of X Windows. Scheifler et al. pg. 80 last full paragraph. Moreover, the "definitions" referred to for VGTS are note data objects as taught by Applicants. Rather, they are but graphic element descriptions provided in a definition file. Accordingly, it neither discloses nor suggests a data structure capable of including raw program code and display data as proposed by Applicants.

In view of the above, it is clear that Scheiler et al. fail to disclose or suggest Applicants' invention. They do not disclose or suggest generation of screen displays at respective reception systems for requested applications, where the application screen display are generated by the respective reception system from data objects having a prescribed data structure, at least some of which objects are stored at the respective

reception system. Additionally, Scheifler et al. fail to disclose or suggest retrieval of objects from the object store at the respective reception system, or if unavailable at the object store of the respective reception system, retrieval from the network as claimed by Applicants.

Neither Scheifler et al. nor X Windows provides any suggestion for minimizing host processing and network communication in order to speed response to application requests and reduce processing costs as taught by Applicants.

Continuing, the Examiner has also rejected Applicants' claims 2-4 as obvious, in view of the Scheifler et al. disclosure. At the bottom of pg. 5 of the Action, the Examiner contends that Scheifler et al. discloses generation of partitions from objects as taught by Applicants. For the reasons noted above, and incorporated here by reference, the Examiner's contention is not true. Scheifler et al. does not disclose or suggest data objects for containing application program code and/or display data to facilitate transport to, storage at and execution by the reception system as taught by Applicants. And, it further follows that in view of that basic deficiency, neither does Scheifler et al. disclose the structure of objects as including a header and one or more data segments as taught by Applicants, which features by amendment have now been expressly presented in claim 2-4.

Still further and continuing with respect to claims 2-4, the Examiner nakedly asserts at pg. 6 of the Action that Scheifler et al. implicitly disclose a first subgroup of commands selectable to permit random movement between application. Once again, this assertion is devoid of technical merit. As disclosed by Scheifler et al. and others, X Server of X Windows does not control the application which is execution at the host. Rather, the X Server merely accepts display information generated by the application for presentation in windows generated by the X Server, and passes terminal keyboard events to the host for translation and processing by the application. Moreover, the Examiner's speculations about how X Windows might be modified absent some suggestion in the art will not support a rejection for obviousness. Indeed, the only motivation to make such a modification comes from hindsight based on Applicants' teaching. However, as described below, the Court of Appeals for Federal Circuit and

its predecessor the Court of Customs and Patent Appeals have repeated condemned use of hindsight reconstruction based on an applicant's teaching. In X Windows, navigation to other application must be done through the host. Scheifler et al. neither discloses nor suggests Applicants' claims 2-4.

With regard to the Examiner's rejection of Applicants' claims 8 and 8/9, for the reasons noted above in connection with the discussion of claims 1-4, which reasons are incorporate herein, the Examiner's contention that claims 8 and 8/9 are obvious in view of Scheifler et al. is also improper and must be withdrawn.

At pg. 7 of the Action, the Examiner also contends that Applicants' claims 12-13 are obvious in view of Scheifler et al. Specifically, the Examiner contends that since Scheifler et al. support windows generally, any content, regardless of subject matter can be supported. This contention, is erroneous. As pointed out above, in accordance with Applicants' teaching as claimed, applications and their interface are executed at the reception system. Accordingly, the reception system must have the ability to support the application and its display. In X Windows, as also noted above, this is not the case. Indeed, in X Windows, the X Server looks to the remote host for execution of the application with the attendant price of communication time delay and execution cost. This is expressly what Applicants avoid in storing and processing objects at the reception system. For this and the other reasons noted in connection with the discussion of claim 1, which reasons are incorporated herein, Scheifler et al. does not and can not disclose or suggest Applicants' claimed invention.

With regard to claim 14-17, the Examiner at pg. 7 of the Action also contends that Scheifler et al. renders claims 14-17 obvious. And, once more, for the reasons noted in connection with the claim 1 from which claims 14-17 depend, Scheifler et al. does not and can not disclose or suggest Applicants' claimed method.

Continuing, at Paragraph 4 of the Action, the Examiner also rejects Applicants' claims 5-7, 9/5, 9/6, and 9/7 as obvious in view of Scheifler et al. as combined with Microsoft Windows, version 2.0. Specifically, the Examiner expressly admits that Scheifler et al. fail to disclose or suggest the provision for entering a character string at the reception system to effect application navigation. However, the Examiner contends

that Microsoft Windows 2.0 provides such a technique, and that it would be obvious to combine the teaching of Scheifler et al. to render Applicants' teaching obvious.

The Examiner's contentions, however, are, again, incorrect both as a matter of law and as a matter of fact. To establish a prima facie case of obviousness based on a combination of references, the Examiner must show some motivation in the art other than Applicants' disclosure for such a combination. A reading of Scheifler et al. and the Microsoft Windows 2.0 user guide cited shows none exists. The only motivation for the combination is hindsight reconstruction based on Applicants' teaching. Moreover, it is to be noted that X Windows and Microsoft Windows are incompatible systems. X Windows is UNIX based and Microsoft Windows is DOS based. As is well understood by those skilled in the art, features built into one system; e.g., DOS, may not be incorporated in the other; e.g., UNIX, without potentially substantial engineering modification, modification that is nowhere suggested. As the Examiner well knows, simply picking and choosing features from multiple references to build a mosaic absent some suggestion in the art is impermissible. The asserted combination is improper and the rejection must be withdrawn.

Yet additionally, the claims 5-7, 9/5, 9/6, and 9/7 are also distinguished over the cited by virtue of Applicants claimed use of data objects having a prescribe data structure and there predetermined storage. These claims are neither disclosed or suggest by the art asserted.

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through previously selected applications. But, the Examiner contends that Peters provides such a teaching and that its teaching can be combined with the Scheifler et al. disclosure to render Applicants' claims 10-11 obvious.

Once again, however, the Examiner's assertions are incorrect as a matter of law and as a matter of fact. To establish a *prima facie* case of obviousness based on a combination of references, the Examiner must show some motivation in the art other than Applicants' disclosure for such a combination. A reading of Scheifler et al. and the Peters cited shows none exists. The only motivation for the combination is hindsight reconstruction based on Applicants' teaching. And, again, it is to be noted that X Windows is a unique system that requires a series of cooperating modules; for example, X Server, X Wire, and at least X Lib. There is no indication that the teaching of Peters can be integrated with X Windows. Moreover, X Windows and its X Server are not concerned with applications. As described, application management is undertaken by the network host running the application. No suggestion exists in the X Windows teaching to provide for another module to track application history. Still further, there is likewise no indication that the X Server and its modest resources as described by Scheifler et al. could accommodate such a facility. Plainly, it is only hindsight reconstruction based on Applicants' teaching that motivates the Examiner to assert a combination of Scheifler et al. and Peters. The rejection is improper and must be withdrawn.

Still further, it is to be noted that claims 10 and 11 depend from Applicants' claim 2, and as a result are also distinguished over the asserted art by virtue of Applicants' claimed use of data objects having a prescribed data structure including a header and one or more data segments and their predetermined storage. These claims are neither disclosed or suggested by the applied art. The rejection is improper and must be withdrawn.

THE LAW

As noted above, the Examiner contention that Applicants' invention is obvious in view of the citations asserted and, accordingly, unpatentable, is a misapplication of 35 U.S.C. §103, the relevant law in this case.

In pertinent part, 35 U.S.C. §103, provides:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

35 U.S.C. §103(a) (1995).

With regard to the determination of whether or not claimed subject matter can be considered obvious, and therefor, unpatentable under §103, the United States Supreme Court has said:

While the ultimate question of patent [claim] validity is one of law ... the §103 condition, ... lends itself to several basic factual inquiries. Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.

Graham v. John Deere Co., 383 U.S. 1, 17-18 [148 USPQ 459, 467] (1966).

As the Supreme Court stated, the test for obviousness is based on a factual determination - and as the Court went on to acknowledge - a factual determination that would not be without difficulty in applying. Indeed, courts that administer the test have established that those who would seek to have claimed subject matter declared obvious have the burden of first showing with factual evidence:

- (1) What the scope and content of the prior art is;

- (2) What the difference between the prior art and the claimed invention are ;
- (3) What the level of ordinary skill in the art is; and
- (4) To the extent present, the relevance of indicia such as commercial success, long felt want and failure of others.

Then, and only then, the courts have said, can it be determined whether the claimed invention, as a whole, would have been obvious to a person of ordinary skill in the art at the time the invention was made. *In re Mayne*, 104 F.3d 1339, 41 U.S.P.Q.2d 1451, 1453 (C.A.F.C. 1997), citing *In re O'Farrell*, 853 F.2d 894, 902, 7 U.S.P.Q.2d 1673, 1680 (Fed. Cir. 1988); *Miles Lab., Inc. v. Shandon Inc.* 997 F.2d 870, 877, 27 U.S.P.Q.2d 1123, 1128 (Fed. Cir. 1993); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538, 218 U.S.P.Q. 231, 236 (Fed. Cir. 1983) and *In re Durden*, 763 F.2d 1406, 1410, 226 U.S.P.Q. 359, 361 (Fed. Cir. 1985).

Because of the potential complexity associated with application of the *Graham* test, the courts have had to develop procedural rules to enable the orderly prosecution of obviousness determination. In that regard, the Court of Appeals for the Federal Circuit and its predecessor the Court of Customs and Patent Appeals have established that the Patent and Trademark Office shall have the burden of making a *prima facie* case whenever it seeks to deny the patentability of claimed subject matter. *In re Mayne*, 104 F.3d 1339, 41 U.S.P.Q.2d 1451, 1453 (C.A.F.C. 1997), citing *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1530 (Fed. Cir. 1993); and *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

For example, in *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992), Judge Newman speaking for the Court said:

The *prima facie* case is a procedural tool of patent examination, allocating the burdens of going forward as between examiner and applicant. *In re Spada*, 911 F.2d 705, 707 n.3, 15 USPQ2d 1655, 1657 n.3 (Fed. Cir. 1990). The term " *prima facie* case" refers only to the initial examination step. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). As discussed in *In re Piasecki*, the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting

a prima facie case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant.

After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument. See *In re Spada*, *supra*; *In re Corkill*, 771 F.2d 1496, 1500, 226 USPQ 1005, 1008 (Fed. Cir. 1985); *In re Caveny*, 761 F.2d 671, 674, 226 USPQ 1, 3 (Fed. Cir. 1985); *In re Johnson*, 747 F.2d 1456, 1460, 223 USPQ 1260, 1263 (Fed. Cir. 1984).

If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent. See *In re Grabiak*, 769 F.2d 729, 733, 226 USPQ 870, 873 (Fed. Cir. 1985); *In re Rinehart*, *supra*.

Id. at 1444.

And, the Federal Circuit, on a number of occasions, has also pointed out what will be required in making out a *prima facie* case. For example, in the common situation where the examiner rejects claims as obvious based on an asserted combination of references, as pointed out by Judge Rich in *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991), that rejection will be sustained only where the art both provides the suggestion for the combination asserted and the expectation the combination would be successful. And, yet further, Judge Rich notes that the suggestion for the combination and the likelihood of success can not come from the applicant's disclosure. Specifically Judge Rich wrote:

Where claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under § 103 requires, inter alia, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success. See *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure. *Id.* (emphasis added)

Id. at 1442.

Indeed, the Patent and Trademark Office has acknowledged its obligations under the law and expressly instructed its examiners in accord with court-expressed requirements as to what the examiner must demonstrate in order to establish a *prima facie* case of obviousness. Specifically, in the *Manual of Patent Examining Procedure* (MPEP) the Patent and Trademark Office mandates:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

MPEP §2143 (Sixth Ed. 1995, Rev. July 1996).

FAILURE OF THE EXAMINER TO FOLLOW THE LAW

In the current application, however, despite the clarity of the law as articulated by the Supreme Court, the Court of Appeals for the Federal Circuit and the Court of Customs and Patent Appeals, and the express directives of the Patent and Trademark Office itself, the Examiner has elected not to follow the established rules.

Specifically, the Examiner has not established a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). He has failed to read Applicants' claims in light of their specification. *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). He has failed to consider all the express limitations of the claims. *In re Fine* 837 F.2d 1071, 5 U.S.P.Q. 2d 1596 1600, (Fed. Cir. 1988); *In re Lowry*, 32 F.3d 1579, 32 U.S.P.Q.2d 1031 (Fed. Cir. 1994). He has failed to treat the claimed invention as a whole, and rather sought to apply a piecemeal attack of individual claim elements. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 [148 USPQ 459, 467] (1966). He has failed to provide evidence to show the art relied on would have lead one skilled in the field to make the combination asserted. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443, 1446, 47 (Fed. Cir. 1992); *In re Clay*, 966 F.2d 656 23 U.S.P.Q.2d 1058, 1061 (Fed. Cir. 1992). He has failed to identify any suggestion or motivation in

the art for the combination; *In re Bell*, 991 F.2d 781, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993); *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992); or any likelihood the combination asserted would have been successful in resolving the problem addressed by the Applicants. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). He has applied impermissible hindsight based on Applicants' teaching to establish the combination of references asserted. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). And, he has failed to follow the requirements of the Patent and Trademark Office established for assessing obviousness as set out in §2143 *et seq.* of the *Manual of Patent Examining Procedure* (Sixth Ed. 1995, Rev. July 1996).

More specifically, the Examiner has refused to read Applicants claims in light of the specification. As is fully disclosed in Applicants specification, the "objects" recited in Applicants claim 1, from which all other claims depend, are data object having a prescribed data structure. While Applicants do not expect limitations recited only in the specification to be read into the claims, still the Examiner is required to read express limitations recited for what they are. It is plain from Applicants' specification at pg. 15, ln. 14 - pg. 24, ln. 32, that "objects" are data structures, not graphical representation or any other fanciful contrivance the Examiner can imagine as he seeks to assert. The Examiner rejection in Paragraph 3 of the Action, accordingly for the reasons noted here and above in connection with discussion of Applicants claims is improper and must be withdrawn. *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

Further, the Examiner has not consider express limitations included in Applicants' claims. The Examiner has not considered at all that Applicants' claim 1 expressly requires inclusion of command functions at the display that would permit movement between applications. As noted in X Windows, application management is handled at the host not the terminal; i.e., reception system. Further, the Examiner has failed to consider that the screen displays are generated by reception system for data objects executed at the reception system. Accordingly, the Examiner rejection in Paragraph 3 of the Action, for the reasons noted here and above in connection with

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discussion of Applicants claims is improper and must be withdrawn. *In re Fine* 837 F.2d 1071, 5 U.S.P.Q. 2d 1596 1600, (Fed. Cir. 1988).

Still further, in rejecting Applicants' claims 5-7, 9/5, 9/6, and 9/7, based on a combination of the Scheifler et al. citation and the Microsoft Windows Version 2.0 guide, the Examiner has failed completely to provide any motivation for the asserted combination other than Applicants' teaching and has additionally failed to suggest any basis at all for the possible technical success of proposed combinations. Accordingly, the Examiner rejection in Paragraph 4 of the Action, for the reasons noted here and above in connection with discussion of Applicants claims is improper and must be withdrawn. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443, 1446, 47 (Fed. Cir. 1992); *In re Clay*, 966 F.2d 656 23 U.S.P.Q.2d 1058, 1061 (Fed. Cir. 1992). *In re Bell*, 991 F.2d 781, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993); *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992); *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992).

And, likewise, in Paragraph 5 of the Action, the Examiner rejected Applicants' claims 10 and 11 on an unsupported combination, specifically, the Scheifler et al. article in combination with the Peters patent. But, the Examiner has failed to provide any motivation for the asserted combination other than Applicants' teaching and has additionally failed to suggest any basis at all for the possible technical success of proposed combinations. Accordingly, the Examiner rejection in Paragraph 5 of the Action, for the reasons noted here and above in connection with discussion of Applicants claims is improper and must be withdrawn. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443, 1446, 47 (Fed. Cir. 1992); *In re Clay*, 966 F.2d 656 23 U.S.P.Q.2d 1058, 1061 (Fed. Cir. 1992). *In re Bell*, 991 F.2d 781, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993); *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992); *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992).

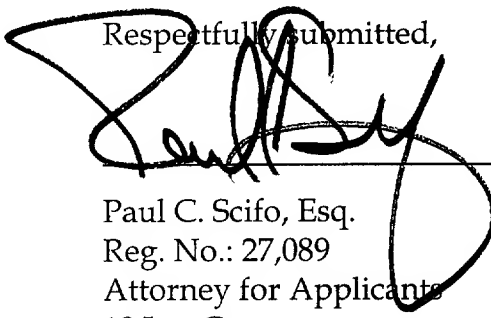
Finally, and as is apparent, from the Examiner has failed to establish a prima facie case of obviousness for Applicants' claimed invention. Accordingly for the reasons note through Applicants above remarks, the Examiner's rejection of Applicants claims must be withdrawn as improper and Applications application allowed. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992).

However, while Applicants believe their invention as claimed is distinguished over the art, in an effort to further clarify those distinctions and to move their application to allowance, Applicants have amended their claims as indicated herein to point out that their application displays and partitions are constructed by the reception system from data object having prescribed data structure which may be stored at the reception system or in the network. Support for the amendments to claim 1 can be found at least at pg. 5, ln. 13 - pg. 6, ln. 28; pg. 9, ln. 27 - pg. 11, ln. 14; pg. 13, ln. 12 - 28; pg. 15, ln. 25 - pg. 24, ln. 32, and pg. 29, ln. 30 to pg. 40, ln 7.

Accordingly, in view of the noted amendments and preceding remarks, Applicants would respectfully submit that their invention is patentably distinguished from the art cited, and, that all objections raised by the Examiner have been resolved. Therefore, Applicants, requests reconsideration of their application and issuance of a patent thereon.

Dated: July 16, 1997,

Respectfully submitted,


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I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231, on July 16, 1997.

Name of Registered Representative: Paul C. Scifo, Esq.

Signature:

Date: July 16, 1997

GAU 2412



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In Re Appln. of: Robert Filepp et al.
Serial No.: 08/158,031
Filed: November 26, 1993
Title: METHOD FOR PRESENTING APPLICATIONS
IN AN INTERACTIVE SERVICE

Group Art Unit: 2412
Examiner: Joseph H. Field

TRANSMITTAL LETTER

The Commissioner of Patents and Trademarks
Washington, D.C. 20231

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Sir:

In connection with the above referenced application, I am enclosing herewith:

- I. A reply to the Office Action of January 16, 1997, the reply including:
 1. An amendment of 23 pages; and
 2. A petition to extend the time to reply by three months; and
- II. In Paragraph 1 of the January 16, 1997 Official Action, the examiner stated that since the PTO was responsible for delaying issuance of the Action, the Applicants would not be required to pay further fees for any time extensions. However, in the event the PTO should subsequently determine that some fee is required to be paid, the PTO is authorized to charge that fee to deposit account number 09-0459 in the name of the International Business Company until such time as Applicants can be heard as to the impropriety of any such fee imposed.

No amendment fee is required based on the following calculation:

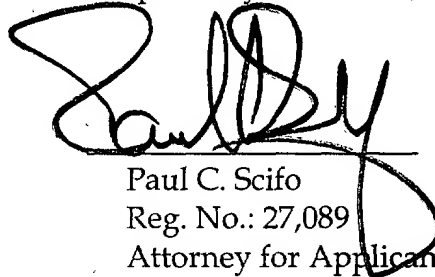
	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NO. PREV. PAID	EXTRA	RATE	FEE
TOTAL:	17	20	0	22.00	\$ 0
INDEP.	1	3	0	80.00	\$ 0
MULTIP. DEP.	1	1	0	260.00	\$ 0
TOTAL					\$ 0

The Commissioner of Patents and Trademarks
July 16, 1997
Page 2

In the event there are any questions concerning these items, please feel free to contact me during business hour either by telephone at (516) 488-2315. Your assistance is appreciated.

Dated: July 16, 1997,

Respectfully submitted,



Paul C. Scifo
Reg. No.: 27,089
Attorney for Applicants

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope address to the Commissioner of Patents and Trademarks, Washington, D.C., 20231 on July 16, 1997.

Name of Registered Representative: Paul C. Scifo, Esq.

Signature:

Date: July 16, 1997.

